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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/974,666

**Applicant(s)**

ELLIS, MICHAEL D.

**Examiner**

ANNAN Q. SHANG

**Art Unit**

2424

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 18-36, 38-56, 58-75 and 77-95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-36, 38-56, 58-75 and 77-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/24/09 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-16, 18-36, 38-56, 58-75 and 77-83 have been considered but are moot in view of the new ground(s) of rejection using the prior arts of record.

With respect to the rejection of the last office action, applicant discusses the prior art of records and the claimed invention, amends claims and argues that the prior art of record does not teach the amended claim limitations, i.e., "...fails to disclose that client-server connection is automatically established...fails to disclose that on-demand media data is automatically retrieved through the client-server connection..." etc., (See page 16+ of Applicant's Remarks).

In response, Examiner disagrees. Examiner notes applicant's arguments, however, Shah Nazaroff discloses a client/server system where Server System 'SS' 140 receives media information from various sources and provides to a client, display (fig.5)

of the received media information to enable a user to interact or request for a particular services. Client 110, interacts to the menu to select a service and the server/client system automatically establishing a client-server connection between the interactive TV application system and the source of the service (PPV, On-demand, etc.); Shah Nazaroff clearly illustrates a communications device for communicating with the on-demand media data source (such as a digital satellite or internet connection "client interacts to a Web server or Service Provider) and non-on-demand media data source (such as a cable system) (fig. 2.230 and col. 4, lines 10-13); A memory (fig. 2.220 and cols. 3 and 4, lines 60-67 and 1-7); A display device (fig. 2.210 and col. 3, lines 50-54); A user input device (fig. 2.210 and col. 3, lines 54-57); and control circuitry (such as that comprising the media system, fig. 1.110) programmed to: receives a broadcast of the non-on-demand media data from the non-on-demand media data source (such as receiving listings information from the broadcast source, video/audio (A/V), A/V upgrades, etc., col. 4, lines 1-7); Identifies, at the user equipment, a set of on-demand media data (TITANIC & AIR FORCE ONE or MECH WARRIOR & SUPPER FUN HOUSE, A/V, A/V upgrades, etc.) that corresponds to some of a plurality of on-demand media necessary for retrieval (fig.5 and col.6, lines 15-48); Automatically initiating, at the user equipment, a client-server (interaction with Internet Service Provider or Web Server) connection between the interactive TV application system and the on-demand media data source in response to the identifying of on-demand media data necessary for retrieval; Automatically retrieving the on-demand media data corresponding to the identified set (A/V, A/V upgrades) from the on-demand media data source though the

client-server connection; and automatically storing the media data in memory on the user TV equipment (receives and stores a recordable version or downloading and recording A/V and/or A/V upgrades, col. 3, line 1-col.4, line 7, line 33-col.5, line 3 and col.6, lines 1-48); and further displays the on-demand media data stored in the memory of the user TV equipment in response to a user indication to access at least the on-demand media data; and displaying the non-on-demand media data in response to a user indication to access at least the non-on-demand media (such as the user playing back the stored A/V and/or A/V upgrades, col. 3, line 1-col.4, line 7, line 33-col.5, line 3 and col.6, lines 1-48). Hence the amended/unamended claims do not overcome the prior arts of record. The 102(e) rejection and the various 103(a) rejection meets all the claim limitations as discussed below. The amendment to the claims necessitated the new ground(s) of rejection discussed below. **This office action is non-final.**

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4-5, 7, 18-22, 24-25, 27, 38-42, 44-45, 47, 58-62, 64-65, 67 and 78-83 are rejected under 35 U.S.C. 102(e) as being anticipated by **Shah-Nazaroff et al (6,157,377)**.

As to Claims 1, 21, 41, and 61, **Shah-Nazaroff** discloses a method, computer readable medium, and system for retrieving data for use in an interactive television application system having an interactive TV application implemented at least partially on user TV equipment in which non-on-demand media data is provided by a non-on-demand media data source (such as pay-per-view listings from a cable satellite source, fig. 5) and a plurality of on-demand media data is provided by an on-demand media data source (such as on-demand video listings from a satellite source or video game listings from an Internet source, fig. 5), and wherein the non-on-demand and on-demand media data sources are separate, comprising:

A communications device for communicating with the on-demand media data source (such as a digital satellite or internet connection "client interacts to a Web server or Service Provider) and non-on-demand media data source (such as a cable system) (fig. 2.230 and col. 4, lines 10-13); A memory (fig. 2.220 and cols. 3 and 4, lines 60-67 and 1-7); A display device (fig. 2.210 and col. 3, lines 50-54); A user input device (fig. 2.210 and col. 3, lines 54-57); and control circuitry (such as that comprising the media system, fig. 1.110) programmed to:

Receiving a broadcast of the non-on-demand media data from the non-on-demand media data source (such as receiving listings information from the broadcast source, video/audio (A/V), A/V upgrades, etc., col. 4, lines 1-7);

Identifying, at the user equipment, a set of on-demand media data (TITANIC & AIR FORCE ONE or MECH WARRIOR & SUPPER FUN HOUSE, A/V, A/V upgrades, etc.,) that corresponds to some of a plurality of on-demand media necessary for retrieval (fig.5 and col.6, lines 15-48);

Automatically initiating, at the user equipment, a client-server (interaction with Internet Service Provider or Web Server) connection between the interactive TV application system and the on-demand media data source in response to the identifying of on-demand media data necessary for retrieval; Automatically retrieving the on-demand media data corresponding to the identified set (A/V, A/V upgrades) from the on-demand media data source through the client-server connection;

Automatically storing the media data in memory on the user TV equipment (receives and stores a recordable version or downloading and recording A/V and/or A/V upgrades, col. 3, line 1-col.4, line 7, line 33-col.5, line 3 and col.6, lines 1-48);

Displaying the on-demand media data stored in the memory of the user TV equipment in response to a user indication to access at least the on-demand media data; and displaying the non-on-demand media data in response to a user indication to access at least the non-on-demand media (such as the user playing back the stored A/V and/or A/V upgrades, col. 3, line 1-col.4, line 7, line 33-col.5, line 3 and col.6, lines 1-48).

As to Claims 2, 22, 42, and 62, Shah-Nazaroff discloses that the non-on-demand media data retrieved is television program listings data (such as pay-per-view listings, fig. 5).

As regards Claims 4, 24, 44, and 64, Shah-Nazaroff discloses that the on-demand media data retrieved is interactive television application software data (such as Mech Warrior 6000, fig. 5).

As regards Claims 5, 25, 45, and 65, Shah-Nazaroff discloses that the on-demand media data retrieved is video-on-demand listings data (such as for an on-demand movie "Titanic," fig. 5).

As regards Claims 7, 27, 47, and 67, Shah-Nazaroff discloses that the on-demand media data retrieved is interactive video games listings data (such as Mech Warrior 6000, fig. 5).

As regards Claims 18, 38, 58, and 78, Shah-Nazaroff discloses that retrieving on-demand media data from multiple on-demand media data sources (such as Satellite and the Internet, fig. 5).

As regards Claim 19, 39, 59, and 79, Shah-Nazaroff discloses caching on-demand media data from multiple on-demand media data sources (such as storing program data from a variety of on-demand media sources like Satellite and the Internet in a program database, fig. 2.220, cols. 3 and 4, lines 59-67 and 1-7).

As regards Claim 20, 40, and 60 Shah-Nazaroff discloses displaying non-on-demand media data and on-demand media data concurrently (fig. 5).

Claims 80-83 are met as previously discussed with respect to claim 1, 21, 41 and 61 above.



5. Claims 3, 23, 43, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Hofmann (5,883,677)**.

As regards Claims 3, 23, 43, and 63 Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose that the on-demand media data retrieved is genre data.

**Hofmann** discloses that the on- demand media data retrieved is genre data (figs. 5 and 6 and col. 8, lines 32-41, or such as labeling a program as a comedy, figs. 9A and 9B).

At the time of the invention it would have been obvious to one skilled in the art to include the genre data, as done in Hoffman, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user additional helpful information about his viewing choices.

6. Claims 6, 26, 46, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Mathews, III (US 5,815,145)**.

As regards Claims 6, 26, 46, and 66 Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21,41, and 61 but fails to disclose that the on-demand media data retrieved is audio-on-demand listings data.

**Mathews** discloses that the on-demand media data retrieved is audio-on-demand listings data (col. 9, lines 40-49).

At the time of invention, it would have been obvious to one skilled in the art to

add the audio-on-demand listings of Mathews, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user more on-demand media options.

7. Claims 8-9, 13, 28-29, 33, 48-49, 53, 68-69, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Banker (US 5,485,221)**.

As regards Claims 8, 28, 48, and 68, Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61, but fails to disclose that the on-demand media data retrieved is weather data.

**Banker** discloses that the on-demand media data retrieved is weather data (col. 6, lines 37-43).

At the time of invention, it would have been obvious to one skilled in the art to add the weather data of Banker, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user more information options.

As regards Claims 9, 29, 49, and 69, Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose that the on-demand media data retrieved is sports statistics data.

Banker discloses that the on-demand media data retrieved is sports statistics data (such as scores, col. 6, lines 37-43).

At the time of invention, it would have been obvious to one skilled in the art to add

the sports statistics data of Banker, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user more information options.

As regards Claims 13, 33, 53, and 73 Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21,41, and 61 but fails to disclose retrieving on-demand media data from the on-demand media data source in response to a user selection of an on-demand media listing.

Banker discloses retrieving on- demand media data from the on-demand media data source in response to a user selection of an on-demand media listing (such as by navigating the IPG menu options fig. 5A to reach sports information fig. 5C.550).

At the time of invention, it would have been obvious to one skilled in the art to add the additional retrieval of Banker, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user a structured, easy-to-use way of accessing additional data.

8. Claims 10, 30, 50, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Lett (US 5,771,064)**.

As regards Claims 10, 30, 50, and 70, Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21,41, and 61 but fails to disclose that the on-demand media data retrieved is stock market data:

Lett discloses that the on-demand media data retrieved is stock market data (col. 6, lines 37-43).

At the time of invention, it would have been obvious to one skilled in the art to add the stock market data of Lett, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user more information options.

9. Claims 11-12, 31-32, 51-52, and 71-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Lewis (US 2003/0040962)**.

As regards Claims 11, 31, 51, and 71, Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose providing metadata contemporaneously with non-on-demand media data.

Lewis discloses providing metadata (such as embedded control data that allows a user to edit or remove certain sections of the media) contemporaneously (such as by transmitting data along with the broadcast data, paragraph 72, lines 1-5) with non-on-demand media data (figs. 3H and 3I, and paragraphs 95, 96, and 97).

At the time of invention, it would have been obvious to one skilled in the art to add the metadata of Lewis, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user more opportunities to customize the media program being watched.

As regards Claims 12, 32, 52, and 72, Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose providing metadata contemporaneously with on-demand media data.

Lewis discloses providing metadata (such as embedded control data that allows a user to edit or remove certain sections of the media) contemporaneously (such as by transmitting data along with the broadcast data, paragraph 72, lines 1-5) with on-demand media data (figs. 3H and 3I, and paragraphs 95, 96, and 97).

At the time of invention, it would have been obvious to one skilled in the art to add the metadata of Lewis, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user more opportunities to customize the media program being watched.

10. Claims 14-15, 34-35, 54-55, and 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Aristides (US 5,630,119)**.

As regards Claims 14, 34, 54, and 74, Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose determining if the on-demand media data is stored.

Aristides discloses determining if the on-demand media data is stored (col. 6, lines 27-32).

At the time of invention, it would have been obvious to one skilled in the art to add the caching of Aristides, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to provide a smoother experience to the user.

As regards Claims 15, 35, 55, and 75, Shah-Nazaroff discloses the method and computer readable medium of Claims 1, 21, 41, and 61 but fails to disclose determining

if the on-demand media data needs to be retrieved from the on-demand media data source. Aristides discloses determining if the on-demand media data needs to be retrieved from the on-demand media data source (such as from the program guide head-end, col. 6, lines 32-39).

At the time of invention, it would have been obvious to one skilled in the art to add the caching of Aristides, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to provide a smoother experience to the user.

11. Claims 16, 36 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Rosin (US 6,028,600)**.

As regards Claims 16, 36 and 56 Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose determining whether a connection exists between the interactive television application system and the on-demand media data source.

Rosin discloses determining whether a connection exists between the interactive television application system and the on-demand media data source (Abstract, fig. 12, and col.15, lines 43-47).

At the time of invention, it would have been obvious to one skilled in the art to add the determination of a connection of Rosin, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to insure that a connection exists before any attempt at retrieving the on-demand media is made.

12. Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Hooper (US 5,414,455)**.

As regards Claim 77, Shah-Nazaroff discloses the method, computer readable medium, and system of Claim 61, but fails to disclose establishing a connection between the interactive television application system and the on-demand media data source.

Hooper discloses establishing a connection between the interactive television application system and the on-demand media data source (Abstract, fig. 12, and col. 15, lines 43-47).

At the time of invention, it would have been obvious to one skilled in the art to add the establishing of a connection of Hooper, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to insure that a connection exists before any attempt at retrieving the on-demand media is made..

13. Claims 84-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Killian (6,163,316)**.

As to claims 84-95, Shah-Nazaroff teaches all the claim limitations has previously discussed with respect to claims 1, 21, 41 and 61, but silent as to where the identifying is based on a viewing history stored on the user TV equipment, where the viewing is based on monitored user activity and where the history comprises at least one of on-demand media that is commonly accessed by a user, on-demand media that is likely to

be accessed by the user and on-demand media that is popular among a plurality of users.

However, in the same field of endeavor, Killian discloses EPG system and method and further discloses monitoring (passively and actively) and identifying a user viewing history stored on the user TV equipment and where the history comprises at least one of on-demand media that is commonly accessed by a user, on-demand media that is likely to be accessed by the user and on-demand media that is popular among a plurality of users (figs.1, 6, 7, col.2, lines 1-46 and col.16, line 8-col.8, line 1+).

Hence it would have been obvious to one skilled in the art at the time of the invention to incorporate the teaching of Killian into the system of Shah-Nazaroff to determine and generate media data or A/V programs that is most likely to appeal to the viewers.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Williams et al (5,945,988) disclose method and apparatus for automatically determining and dynamically updating user preferences in an entertainment system.



15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA) or 571-272-1000**

/Annan Q Shang/  
Primary Examiner, Art Unit 2424

**Annan Q. Shang**